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APPLICATION FOR PATENT TERM
ADJUSTMENT UNDER 37 CFR §1.705(b)
Patent Application
Docket No. C.R.106

December 18, 2009
Frank C. Eisenschenk

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner : Christine J. Saoud
Art Unit : 1647
Applicants : Richard J. Fagan *et al.*
Serial No. : 10/538,962
Filed : November 13, 2006
For : Splice Variant of Human Placental Growth Hormone

Mail Stop Patent Ext.
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

APPLICATION FOR PATENT TERM
ADJUSTMENT UNDER 37 CFR §1.705(b)

Sir:

The applicants received the above-identified granted patent. The final determination of Patent Term Adjustment (PTA) Under 35 U.S.C. 154(b) shown on the cover of the patent indicates 41 days of PTA. The applicants believe that this patent is entitled to an additional 157 days of PTA, for the following reasons:

The subject application was filed as a national stage application pursuant to 35 U.S.C. §371 on June 17, 2005. The applicants fulfilled the requirements of 35 U.S.C. §371 for this application on November 13, 2006. A review of the PAIR record shows that the Patent Office apparently calculated the "B-delay" in the application based upon the November 13, 2006 date. However, a review of the relevant statutes and regulations shows that the actual date to be used with regard to the calculation of B-delay time-limits is the date on which national filing "commenced" pursuant to 35 U.S.C. §§371(b) and (f), *i.e.*, 30-months from the earliest claimed priority date. Furthermore, a recent Patent Office decision in U.S. Patent No. 7,465,444 concurred that the filing date of an application filed

under 35 U.S.C. §371 is the date of expiration of the applicable time limits under PCT articles 22(1) or (2), *i.e.*, the 30-month date.

The priority date claimed in the international application from which the subject national application was filed was December 20, 2002. Therefore, the applicants assert that the date on which national filing “commenced” in the subject application was June 20, 2005, *i.e.*, 30 months from the earliest claimed priority date. The patent for the subject application was subsequently granted on October 20, 2009. This constituted 487 days of “B-delay” on the part of the Patent Office. The Office has asserted that any “A-delay” during prosecution must necessarily overlap with any “B-delay”. Therefore, if the 487 days of B-delay are reduced by 165 days of Patent Office delay and 124 days of applicant delay, as shown in the PAIR record, the subject application should still be entitled to 198 days of PTA.

Notwithstanding the above assertions, applicants put forth the following argument that the actual filing date of the subject application is the date on which the application was received by the Patent Office. 35 U.S.C. 372(a) pertains to national stage requirements and procedures and states that:

(a) All questions of substance and, within the scope of the requirements of the treaty and Regulations, procedure in an international application designating the United States shall be determined as in the case of national applications regularly filed in the Patent and Trademark Office. (emphasis added)

Further, 35 U.S.C. 111(a)(4) pertains to the necessary documentation for receiving a filing date in a regular application and states that:

(4). . . The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office. (emphasis added)

As such, 35 U.S.C. 21 states that:

(a) The Director may by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service or would have been deposited with the United States Postal Service but for postal service interruptions or emergencies designated by the Director. (emphasis added)

In view of the foregoing, it stands to reason that the filing date of a national stage application is the date on which the complete specification is deposited with the United States Postal Service, which for the subject application was June 17, 2005.

Bearing these facts in mind, the applicants assert that the patent for the subject application should have been granted by June 17, 2008. However, as mentioned above, the patent for the subject application did not grant until October 20, 2009. This constituted 490 days of "B-delay" on the part of the Patent Office. If, as above, the total B-delay is reduced by total A-delay during prosecution, which would be 165 days of Patent Office delay and 124 days of applicant delay, as shown in the PAIR record, the subject application should still be entitled to 201 days of PTA.

In view of the above discussion, the applicants respectfully submit that based upon the 30-month expiration date, they are entitled to at least 198 days of total Patent Term Adjustment (487 days of Patent Office B-delay – 165 days of Patent Office A-delay - 124 days of applicant A-delay). However, the applicants further submit that, based upon the actual filing date of the application, they are entitled to 201 days of total Patent Term Adjustment (490 days of Patent Office B-delay – 165 days of Patent Office A-delay- 124 days of applicant A-delay).

The applicants respectfully request that the record of this application be reviewed and that a Certificate of Correction be issued that indicates the correct Patent Term Adjustment. This application is not subject to a terminal disclaimer.

Please charge the fee of \$200 for this Application for Patent Term Adjustment to Deposit Account No. 19-0065. Any additional fees as required by 37 CFR §§1.16 or 1.17 should be charged to Deposit Account No. 19-0065.

Respectfully submitted,



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